

REMARKS

I. Status of claims

By this Amendment, Applicants amend claims 27 and 41 and add new claims 48-50.

Claims 1-50 are therefore pending in this application.

In the Office Action of June 16, 2004,¹ claims 1-26 and 32-47 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter; claims 1, 3, 6-9, 12-18, 20-31, 41-45 and 47 were rejected under 35 U.S.C. § 102(e) as anticipated by PCT International Publication No. WO 01/18674 A2 ("*Maloney*"); claim 10 was rejected under 35 U.S.C. § 103(a) as unpatentable over *Maloney* in view of U.S. Patent Application Publication No. 2002/0082869 ("*Anderson*"); claims 2, 4, 5, 11, 19, 32-40 and 46 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Maloney* in view of PCT International Publication No. WO 02/082350 ("*Maeng*"); and claim 19 was rejected under 35 U.S.C. § 103(a) as unpatentable over *Maloney*. Applicants address the rejections and new claims below.

II. Rejection of claims 1-26 and 32-47 under 35 U.S.C. § 101

Applicants traverse the rejection of claims 1-26 and 32-47 under 35 U.S.C. § 101 for the following reasons.

The Examiner alleged (Office Action "OA" at 2) that 1-26 and 32-47 do not include recitations "in the technological arts." The Examiner further alleged that the claimed invention is directed to "abstract ideas which can be performed mentally without interaction of a physical structure" and that the claims are therefore not permitted under 35 U.S.C. § 101. According to

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

the Examiner, the “method steps may be understood as merely obtaining . . . advise (sic) from a beauty consultant at a beauty salon” (OA at 2). Applicants respectfully disagree.

According to the Federal Circuit, the inquiry of whether a claim is statutory focuses on “the essential characteristics of the subject matter, in particular, its practical utility.” *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1375 (Fed. Cir. 1998). If a claim includes recitations that produce “a concrete, tangible and useful result,” the claim is not abstract and has practical utility. *See State Street*, 149 F.3d at 1373; *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Cir. 1999). And if the claim is not abstract and has practical utility, it is statutory under 35 U.S.C. § 101.

Furthermore, Applicants point out that whether or not a process can be performed “without interaction of a physical structure” is not dispositive of determining whether a claimed process is statutory. In fact, the Federal Circuit has indicated that arguing that process claims are not patentable subject matter because they lack physical limitations “reflects a misunderstanding of...[the] case law.” *AT&T*, F.3d at 1359.

The Office Action fails to establish a *prima facie* showing that claims 1-26 and 32-47 are directed to “abstract ideas.” The Examiner’s conclusory statements that the claims do not “recite a limitation in the technological arts” and that the recitations “are abstract ideas which can be performed mentally without interaction of a physical structure” are wholly unsupported and do not by themselves establish that the claims are directed to abstract ideas. Because the allegations in the Office Action are not supported by proper evidence, the rejection of claims 1-26 and 32-47 under 35 U.S.C. § 101 should be withdrawn.

In addition, claims 1-26 and 32-47 are not abstract but rather statutory. Each of claims 1-26 and 32-47 includes recitations that produce “concrete, tangible and useful” results and

therefore, despite the Examiner's allegations, accomplish a practical application and are not abstract. *State Street*, 149 F.3d at 1375. For example, generating at least one recommendation for use of at least one cosmetic product based on at least one of obtained personal information and local information determined based on demographic information is a useful, non-abstract result that could facilitate, for example, improved beauty product marketing and sales. Likewise, generating at least one recommendation for use of at least one cosmetic product on a generated list, the at least one recommendation being a function of personal information of a subject and local information is a useful, non-abstract result that could facilitate, for example, beauty product marketing and sales.

Moreover, claims 1-26 and 32-47 clearly have tangible applications within the technological arts (*see* Applicants' Specification, e.g., pages 7-11 and 13-20).² As explained above, whether or not the claims include physical structure limitations is not dispositive in determining whether a claimed process is statutory.

For at least the foregoing reasons, the rejection of claims 1-26 and 32-47 under 35 U.S.C. § 101 should be withdrawn.

III. Rejection of claims 1, 3, 6-9, 12-18, 20-31, 41-45 and 47 under 35 U.S.C. § 102(e)

A. Regarding the nature of the rejection

Initially, Applicants point out that the rejection of claims 1, 3, 6-9, 12-18, 20-31, 41-45 and 47 under 35 U.S.C. § 102(e) is improper because *Maloney* is based on an international application filed before November 29, 2000, and is therefore not prior art under

² In referring to the Specification, Applicants do not intend to limit the scope of the claims to the exemplary embodiments shown in the drawings and described in the specification. Rather, Applicants expressly affirm their entitlement to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

35 U.S.C. § 102(e). To the extent *Maloney* qualifies as prior art to Applicants' claims at all, it would potentially be under 35 U.S.C. § 102(a). Applicants therefore request withdrawal of the rejection of claims 1, 3, 6-9, 12-18, 20-31, 41-45 and 47 under 35 U.S.C. § 102(e).

B. Maloney does not anticipate claims 1, 3, 6-9, 12-18, 20-31, 41-45 and 47

The impropriety of the rejection notwithstanding, *Maloney* does not anticipate claims 1, 3, 6-9, 12-18, 20-31, 41-45 and 47. In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102, each and every element of the claim at issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim[s]." *See* M.P.E.P. § 2131. Finally, "[t]he elements must be arranged as required by the claim." *Id.*

With regard to claim 1, *Maloney* fails to teach at least "determining local information based on the demographic information," as claimed. The Examiner alleged (OA at 3) that *Maloney* discloses the claimed "determining" because it mentions delivering to the consumer a test kit that includes environmental tests (*Maloney*, pg. 11, lines 11-12), and also because it discloses identifying "external conditions" (*Maloney*, pg. 10, lines 7-8). Contrary to the Examiner's position, delivering a test kit to a consumer to obtain environmental information does not anticipate "determining local information based on . . . [obtained] demographic information," as claimed. While *Maloney* mentions delivering a test kit to collect profiling information (pg. 11), *Maloney* does not disclose that information used for that delivery is a basis for determining local information. That is to say, even if *Maloney*'s test kit were to obtain "local information," *Maloney* does not disclose that the obtained information is based on demographic information

about the consumer. Indeed, the information obtained from *Maloney*'s test kit is based on environmental tests included in the test kit, not demographic information.

Further, identifying "external conditions," as disclosed by *Maloney* does not teach or suggest the claimed "determining." With *Maloney*'s system, a user "is provided with a list of one or more products ... that correspond to the consumer profiling category" (pgs. 7, 9).

Maloney discloses (pg. 10) that a consumer can customize a product selected from the list.

Maloney then describes identifying, from the consumer, additional data associated with "external conditions (such as water hardness, etc.);" and customizing the selected product to meet these conditions (pg. 10). *Maloney*'s external conditions are not determined "based on . . .

demographic information," as claimed. Even if delivering a test kit to the consumer did in fact indicate that geographic information is obtained, and *Maloney*'s external conditions were construed as "local information," *Maloney* does not disclose that such geographic information is used as a basis for determining the "external conditions." Instead, *Maloney* merely discloses presenting "questions [to the consumer] which elicit the additional consumer profiling data" after the consumer selects a product from a list generated using the originally-collected profiling data (page 10).

For at least the foregoing reasons, *Maloney* does not teach "determining local information based on the demographic information," as claimed. Because *Maloney* does not teach each and every feature of claim 1, as a matter of law, it cannot anticipate claim 1. As such, the rejection of claim 1 as anticipated by *Maloney* should be withdrawn.

Independent claim 25 recites, *inter alia*, "accessing local information for the geographic area." The Examiner alleges (OA at 5) that *Maloney* teaches the claimed "accessing" because it mentions delivering a test kit including environmental tests (*Maloney*, pg. 11, lines 11-12) and

also identifying external conditions, such as water hardness (*Maloney*, pg. 10, lines 7-8).

Applicants disagree with the Examiner's interpretation of *Maloney*. Testing for information, as disclosed by *Maloney*, is not consistent with accessing information, as claimed. Also, presenting questions to elicit information about external conditions, as mentioned by *Maloney*, is not consistent with accessing information, as claimed. *Maloney* does not teach each and every feature of claim 25 and thus, as a matter of law, cannot anticipate this claim.

With regard to independent claim 27, the Examiner alleged (OA at 6) that the language "accessing local information for the geographic area" and "generating at least one recommendation for use of at least one cosmetic product, the at least one recommendation being a function of the personal information of the subject and the local information" is non-functional and should not be given patentable weight. Although disagreeing with these allegations, Applicants amend claim 27 to expedite prosecution. Applicants submit that the features of claim 27, as currently presented, should indeed be given patentable weight.

Maloney, moreover, cannot anticipate claim 27 because it fails to teach or suggest at least the following features of claim 27:

memory for storing personal information about a subject, the personal information including at least demographic information about the subject, the demographic information including a geographic area location of the subject;

memory for storing a program that accesses local information for the geographic area and generates at least one recommendation for use of at least one cosmetic product, the at least one recommendation being a function of the personal information of the subject and the local information.

Independent claim 30 recites, *inter alia*, a memory including a program that . . . determines local information based on the demographic information" Similarly, independent claim 31 recites, *inter alia*, "determining local information based on the

demographic information.” While claims 30 and 31 are of different scope than claim 1, *Maloney* does not anticipate these claims for at least reasons similar to those presented above in connection with claim 1.

Independent claim 41, as currently presented, recites a combination including “obtaining local information about a geographic area by manipulating received demographic data.” *Maloney* does not teach at least this feature. Even if *Maloney*’s test kit were to obtain “local information,” *Maloney* does not disclose that such information is obtained by manipulating received demographic information. Delivering a test kit does not anticipate manipulating received demographic information. Further, identifying “external conditions,” as disclosed by *Maloney*, does not anticipate “obtaining local information about a geographic area by manipulating received demographic data,” even if *Maloney*’s “external conditions” were construed as “local information.” Because *Maloney* does not teach each and every feature of claim 41, it cannot anticipate this claim.

Independent claim 43 recites a combination including “determining local information based on the demographic information.” Although claim 43 is of a different scope than claim 1, *Maloney* does not anticipate claim 43 for at least reasons similar to those presented above in connection with claim 1.

Each of claims 3, 6-9, 12-18, 20-24, 26, 28, 29, 42, 44, 45 and 47 depends from 1, 25, 27, 41 or 43 and is not anticipated by *Maloney* by virtue of such dependency. Because *Maloney* fails to anticipate claims 1, 3, 6-9, 12-18, 20-31, 41-45 and 47, a rejection of these claims under 35 U.S.C. § 102 is improper. Applicants thus request withdrawal of the rejection of claims 1, 3, 6-9, 12-18, 20-31, 41-45 and 47 and the timely allowance of these claims.

IV. Rejection of claim 10 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claim 10 under 35 U.S.C. § 103(a) based on *Maloney* and *Anderson* because *prima facie* obviousness has not been established with respect to this claim. To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

Claim 10 ultimately depends from base claim 1. *Maloney* does not teach or suggest each and every feature of claim 1, for the reasons explained above, and thus fails to teach or suggest each and every feature of dependent claim 10. *Maloney* does not teach or suggest at least the “determining” feature recited in claim 1 and required by claim 10. Further, as affirmed by the Examiner (OA at 8), *Maloney* fails to teach the “historical physical characteristics information about relatives” subject matter recited in claim 10.

Anderson does not cure the deficiencies of *Maloney*. *Anderson* is directed to providing and updating customized health care based on an individual’s genome. *Anderson* does not teach or suggest at least “determining local information based on the demographic information,” as claimed. Because neither *Maloney* nor *Anderson* teaches or suggests the claimed “determining,” *prima facie* obviousness has not been established and the rejection of claim 10 under 35 U.S.C. § 103(a) should be withdrawn.

In addition, the required motivation for modifying *Maloney* in view of *Anderson* is lacking. Determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). Further, the desire to combine references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

In this case, the Office Action does not show, by substantial evidence, that a skilled artisan considering *Maloney* and *Anderson*, and not having the benefit of Applicants’ disclosure, would have been motivated to modify *Maloney* in a manner resulting in Applicants’ claimed combination. According to the Examiner, it would have been obvious to a skilled artisan to modify *Maloney* to include the “historical physical characteristics information about relatives” feature allegedly disclosed by *Anderson* “because it would allow [a determination and exclusion of] certain beauty product ingredients which may cause negative health conditions or even diseases to which the consumer may have a predisposition” (OA at 9). The Examiner’s conclusory allegations regarding motivation are not properly supported by evidence on the record and do not establish that a skilled artisan would have been motivated to modify the reference as alleged. For example, the Examiner points to no mention in *Maloney* or *Anderson* regarding the exclusion of beauty product ingredients based on consumer predispositions. The Office Action does not show the alleged motivation to be present in the relied-upon art or in the knowledge generally available to one skilled in the art. Applicants submit that the conclusions in the Office Action pertaining to motivation were not reached based on facts gleaned from the

cited references and that, instead, teachings of the present application were improperly used to reconstruct the prior art.

For at least the foregoing reasons, *prima facie* obviousness has not been established with respect to claim 10. Applicants thus request withdrawal of the rejection of claim 10 under 35 U.S.C. § 103(a) and the timely allowance of this claim.

V. Rejection of claims 2, 4, 5, 11, 19, 32-40 and 46 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 2, 4, 5, 11, 19, 32-40 and 46 under 35 U.S.C. § 103(a) based on *Maloney* and *Maeng* for the following reasons.

In order to maintain a rejection under 35 U.S.C. § 103(a), the references used to make that rejection must qualify as prior art. *Maeng* does not qualify as prior art to Applicants' claims. *Maeng*'s publication date is October 17, 2002, and its international filing date is March 20, 2002. The application under examination has a filing date of December 21, 2001, and also claims priority to U.S. provisional application no. 60/325,559 filed on October 1, 2001. Applicants' filing and priority dates antedate *Maeng*'s publication and international filing dates. Although *Maeng* shows a foreign priority date of April 7, 2001, that foreign priority date cannot be used for prior art purposes. *Maeng*, thus, does not qualify as prior art against Applicants' claims, regardless of whether *Maeng*'s international filing date is usable as a U.S. filing date for prior art purposes. *Maeng*, accordingly, cannot be used in combination with *Maloney* to reject claims 2, 4, 5, 11, 19, 32-40 and 46. For at least this reason, Applicants request withdrawal of the rejection of claims 2, 4, 5, 11, 19, 32-40 and 46 under 35 U.S.C. § 103(a) based on *Maloney* and *Maeng* and the timely allowance of these claims, which are, *prima facie*, in condition for allowance.

VI. Rejection of claim 19 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claim 19 under 35 U.S.C. § 103(a) based on *Maloney* for at least the following reasons.

Claim 19 depends from base claim 1. *Maloney* does not teach or suggest each and every feature of claim 1, for the reasons explained above, and thus fails to teach or suggest each and every feature of dependent claim 19. *Maloney* does not teach or suggest at least the “determining” feature recited in claim 1 and required by claim 19. For at least this reason, the rejection of claim 19 as unpatentable over *Maloney* should be withdrawn.

Further, *Maloney* does not teach or suggest the “suggesting” feature of claim 19. In the Office Action, the Examiner acknowledged that *Maloney* fails to disclose “suggesting that the subject maintain a stock of the plurality of cosmetic products,” as claimed. In rejecting claim 19, the Examiner took Official Notice “that it is well known that there are a lot of consumers using cosmetic product[s] every day,” and alleged that it would have been obvious to a skilled artisan “to modify *Maloney* to include the missing feature “because without maintaining said stock the consumer may run out of cosmetic product . . .” (OA at 11).

Applicants call attention to the provisions of M.P.E.P. § 2144.03, the procedures set forth in the Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy dated February 21, 2002, and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970). An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. Any facts asserted as well-known should serve only to “fill in the gaps” in an insubstantial manner. It is never appropriate to rely solely on “common knowledge” without evidentiary support in the record as the principal evidence upon which a rejection is based.

The “suggesting” feature of claim 19 is not unquestionably well-known and the Office Action has failed to demonstrate the contrary. Stating that “it is well known that there are a lot of consumers using cosmetic product[s] every day” (OA at 11) does not establish that the “suggesting” feature of claim 19 was unquestionably well-known. That consumers might use cosmetic products daily does not support the assertion that it was well known to suggest “that the subject maintain a stock of the plurality of cosmetic products,” as claimed. Further, even if it were well known “that there are a lot of consumers using cosmetic product[s] every day,” this subject matter is not consistent with “suggesting that the subject maintain a stock of the plurality of cosmetic products.”

As M.P.E.P. § 2144.03 makes clear, with regard to Official Notice, “[t]he standard of review applied to findings of fact is the “substantial evidence” standard under the Administrative Procedure Act (APA)” (citations omitted). M.P.E.P. § 2144.03 points out that “an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support” (citations omitted). The Office Action does not provide substantial evidence on the record showing that the features of claim 19 were in fact unquestionably well-known.

Applicants therefore expressly traverse the Official Notice and request that the Examiner either cite a competent prior art reference in substantiation of the conclusions in the Office Action, or else withdraw the rejection. To the extent the Examiner is relying on personal knowledge in alleging that certain features were well known, Applicants request that the Examiner provide an affidavit evidencing such knowledge as factually based and legally competent to support the Examiner’s conclusions. *See* M.P.E.P. § 2144.03.

In addition, the required motivation for modifying *Maloney* is lacking. The Examiner has not shown that a skilled artisan considering *Maloney*, and not having the benefit of Applicants' disclosure, would have been motivated to modify *Maloney* in a manner resulting in Applicants' claimed combination. The Examiner's conclusory allegations regarding motivation are not properly supported by evidence on the record and do not establish that a skilled artisan would have been motivated to modify the reference as alleged. For example, the mere assertion that a "consumer may run out of cosmetic product" (OA at 11) does not establish that a skilled artisan would have been motivated to modify *Maloney* to include the "suggesting" feature of claim 19. Again, the conclusions of obviousness in the Office Action were not reached based on facts gleaned from the cited references and, instead, Applicants' claims were improperly used to reconstruct the prior art.

For at least the foregoing reasons, the rejection of claim 19 under 35 U.S.C. § 103(a) should be withdrawn. Applicants thus request withdrawal of the rejection and the timely allowance of this pending claim.

VII. New claims 48-50

New claim 48 depends from claim 1 and therefore includes all of the features of claim 1. Neither *Maloney* nor *Anderson*, nor any combination thereof, teaches or suggests at least "determining local information based on the demographic information," as recited in claim 1 and required by new claim 48. For at least this reason, new claim 48 should be allowed. Further, neither *Maloney* nor *Anderson*, nor a combination thereof, teaches or suggests "determining the local information by manipulating the demographic information," as recited in new claim 48. Applicants therefore request the timely allowance of new claim 48.

New independent claim 49 recites a combination including "determining local information based on the demographic information and historical information associated with the

geographic area.” Neither *Maloney* nor *Anderson*, nor a combination thereof, teaches or suggests this feature. New claim 49 should therefore be allowed.

New claim 50 should be allowed at least because it depends from claim 49. Further, neither *Maloney* nor *Anderson*, nor a combination thereof, teaches or suggests “projecting local information based on the demographic information and the historical information associated with the geographic area,” as recited in claim 50. Applicants therefore request the timely allowance of new claims 49 and 50.

VIII. Conclusion

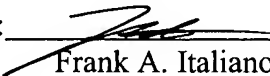
The claimed invention is neither anticipated nor rendered obvious in view of the references cited against this application. Applicants request the Examiner’s reconsideration of the application in view of the foregoing, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: October 18, 2004

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